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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,079	12/12/2001	Yutaka Hasegawa	SUZU:002	6932

7590 02/17/2006

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EXAMINER

BOVEJA, NAMRATA

ART UNIT PAPER NUMBER

3622

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/016,079

Applicant(s)

HASEGAWA, YUTAKA

Examiner

Namrata Boveja

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 12/07/05.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-16 are presented for examination.

#### ***Objections***

2. Claims 1, 5, 9, and 13 are objected to due to the following informalities.

The claims recite "advertisers who subscribe the information service," and the claim should be corrected to recite "advertisers who subscribe **to** the information service." Appropriate correction is required.

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless – (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 4-6, 8-10, 12-14, and 16, are rejected under 102(e) as being anticipated by Yamanaka et al. (Publication Number US 2001/0016834 A1 hereinafter Yamanaka).

In reference to claims 1, 5, 9, and 13, Yamanaka discloses the method, system, a machine-readable medium, and a computer program for managing an information service, which handles distribution of digital contents and presentation of advertising messages to users over a computer network (abstract and page 1 paragraphs 12-16), the system comprising: a first database

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containing advertising messages provided from advertisers (page 1 paragraph 16, page 6 paragraph 117, page 10 paragraph 181, page 15 paragraphs 258, 263, and 264, page 16 paragraphs 271-273, and Figures 4, 5, 14, 15, 23, and 27), who subscribe to the information service with payment of advertisement fees (page 1 paragraph 17, page 2 paragraph 25, page 9 paragraph 153, page 11 paragraph 184, and page 12 paragraph 198); a second database containing a plurality of digital contents which are subject to legal protection on behalf of content proprietors (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28); a presenting section that presents the advertising messages over the computer network to the users who use the information service (page 7 paragraph 119, page 9 paragraph 162, page 15 paragraphs 263 and 264, page 16 paragraphs 271-276, and Figures 7 and 8); a distributing section that distributes the digital contents to the users upon request from the users over the computer network (page 6 paragraph 118 to page 7 paragraph 119, page 8 paragraph 134, page 9 paragraph 152, page 15 paragraphs 261-262, and page 16 paragraph 284); and an allocating section that allocates at least a part of the advertisement fees collected from the subscribing advertisers to the content proprietors of the digital contents distributed to the users (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraph 142, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

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4. In reference to claims 2, 6, 10, and 14, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains protected digital contents subject to legal protection (i.e. content owned by creators and holders excluding distributors that requires the use of an execution key) and non-protected digital contents not subject to legal protection (i.e. content owned by distributors that also may not required the use of an execution key) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs 60 and 67, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 23, 27, and 28), such that the allocating section allocates the collected advertisement fees to the proprietors (i.e. content creators and holders excluding distributors based on the number of times the content was executed as tracked by the execution key) only when the protected digital contents are distributed to the users (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

5. In reference to claims 4, 8, 12, and 16, Yamanaka discloses the method, system, a machine-readable medium, and a computer program wherein the second database contains a multiple of digital contents subject to legal protection on behalf of the same proprietors (i.e. multiple songs by the same artists or from the same CD for which creators and holders own the rights, multiple game titles by the same manufacturer of the game CD's, and multiple movies by the same movie director) (page 1 paragraph 16, page 2 paragraph 24, page 4 paragraphs

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60 and 67, page 7 paragraph 126, page 8 paragraphs 136-139, page 15 paragraphs 258 261, and 262, page 16 paragraphs 284-286, and Figures 7, 8, 23, 27, and 28) such that the allocating section allocates a part of the collected advertisement fees to the same proprietor when any of the multiple of the digital contents is distributed to the users (i.e. pay the proprietors according to each song download on a per song basis regardless if more than one song from the same artist is downloaded or even if the same song is downloaded more than once) (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 7 paragraph 131, page 8 paragraphs 142-143, page 12 paragraph 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 7, 11, and 15 are rejected under U.S.C. 103(a) as being unpatentable over Yamanaka in view of Official Notice.

In reference to claims 3, 7, 11, and 15, Yamanaka discloses contributing digital contents and (i.e. receiving contents from a holder) (page 4 paragraph 67) allocating the collected advertisement fees only for registered (i.e. accepted or obtained or under contractual agreement) (page 4 paragraph 67) distributed contents that are under the legal protection as indicated by the use of an

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execution key by these content holders (page 1 paragraph 17, page 2 paragraph 25, page 4 paragraph 61, page 8 paragraphs 142-143, page 12 paragraphs 198 and 200, page 13 paragraph 226, page 20 paragraph 343, and Figure 20).

Yamanaka doesn't specifically teach the use of status information (i.e. presence information for indicating contents subject or not subject to legal protection) indicating whether or not the contributed digital contents are subject to the legal protection and using the status information in allocating advertisement fees to those that are indicated by the status information. Official Notice is taken that it is old and well known to indicate the status information for digital content by graphics arts companies to ensure that the image they use for example in creating an advertisement is not copyrighted and can be used and reproduced without paying royalties to other companies and to keep track of any costs associated with using a copyrighted image in case the company desire to make use of copyright images for a design campaign.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the applicant's invention to include the use of status information indicating if the content is subject to legal protection and registering this information in a database to view a complete list of status information of digital contents in an easy to view manner. Furthermore, it would have been obvious to do this in order to ensure payment to the content holder by the distributor as indicated by the data presented from the execution key associated with a particular content holder for the number of times the content was executed by a user can be made quickly and accurately.

**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure include the following.

- a) Dwek Patent Number 6,248,946. Teaches a multimedia content delivery system and method.
- b) Gruenwedel, Erik. "PlayJ media player offers marketers ad space." Brandweek. April 17, 2000. Volume 41. Issue 16. Page 58.
- c) M2 Presswire. "NetBeat: NetBeat embraces new technology to pay artists for downloads." August 29, 2000. Page 1. Teaches paying artists for song downloads while the user accesses content for free by watching an ad in a small window.
- d) Business Wire. "Hiwire and Soundom Ink Deal to Generate Revenue From Internet Music; Innovative Advertising Model Will Use Highly Targeted Ads and Hiwire Sales Network to Keep Music Free." September 20, 2000. Pg. 1. Teaches paying consumers to listen to music and use target advertising to generate revenue to compensate recording artists.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Namrata (Pinky) Boveja whose telephone number is 571-272-8105. The examiner can normally be reached on Mon-Fri, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the

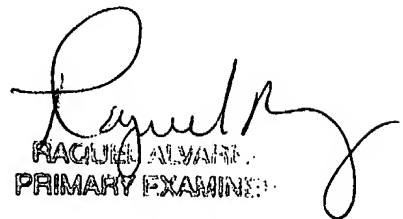


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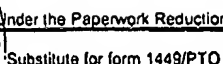
examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8105. On July 15, 2005, the Central FAX Number will change to **571-273-8300**. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 1866-217-9197 (toll-free).

NB

February 9<sup>th</sup>, 2006

RACHEL ALVAREZ  
PRIMARY EXAMINER



Approved for use through 07/31/2006. OMB 0651-0031

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*(Use as many sheets as necessary)*

Sheet	1	of	2
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**Complete if Known**

Application Number	10/016,079
Filing Date	December 12, 2001
First Named Inventor	Yutaka HASEGAWA
Art Unit	3622
Examiner Name	Boveja, Namrata
Attorney Docket Number	SUZU-002

## U. S. PATENT DOCUMENTS

[illegible]

**FOREIGN PATENT DOCUMENTS**

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T
		Country Code <sup>3</sup> * Number <sup>4</sup> * Kind Code <sup>5</sup> (if known)	MM-DD-YYYY			
MB	D	JP 11-85785 A	03-30-1999	ARAI	Abstract/cited in Ref I	
MB	E	JP 11-345261 A	12-14-1999	IKEGAMI et al.	Abstract/cited in Ref I	
MB	F	JP 2001-209722 A	08-03-2001	YAMANAKA et al.	Abstract/cited in Ref I	
MB	G	EP 1 126 424 A2	08-22-2001	YAMANAKA et al.	Abstract/Corr. to Ref F	
MB	H	JP 11-250145 A	09-17-1999	TAKANASHI et al	Abstract/ cited in Ref. J	

Abs only

Examiner  
Signature

Namrata Goveja

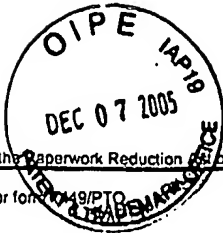
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This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b>  (Use as many sheets as necessary)		<b>Complete if Known</b>	
		Application Number	10/016,079
		Filing Date	December 12, 2001
		First Named Inventor	Yutaka HASEGAWA
		Art Unit	3622
		Examiner Name	Boveja, Namrata
Sheet 2	of 2	Attorney Docket Number	SUZU:002

NON PATENT LITERATURE DOCUMENTS			
Examiner Initials*	Cite No. <sup>1</sup>	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T <sup>2</sup>
NB	I	Notice of Rejection issued on May 10, 2005 for JP 2000-383701, the Priority upon which this application is based. Refs D, E, F were cited in this Notice	✓
NB	J	Decision of Rejection issued on September 6, 2005 for JP2000-383701, the Priority upon which this application is based. Ref. H is cited in this Decision.	✓

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Examiner Signature	Namrata Borgea	Date Considered	2/19/06
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\*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

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<b>Notice of References Cited</b>	Application/Control No. 10/016,079		Applicant(s)/Patent Under Reexamination HASEGAWA, YUTAKA	
	Examiner Namrata Boveja		Art Unit 3622	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-2001/0016834	08-2001	Yamanaka et al.	705/40
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
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	S					
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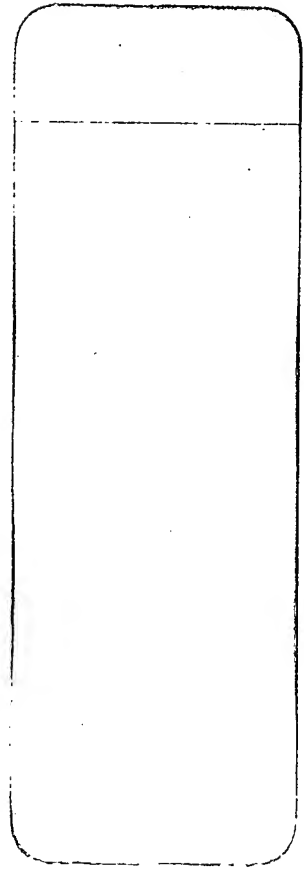
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